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REMARKS

In the November 16, 2005 Office Action, the Examiner:

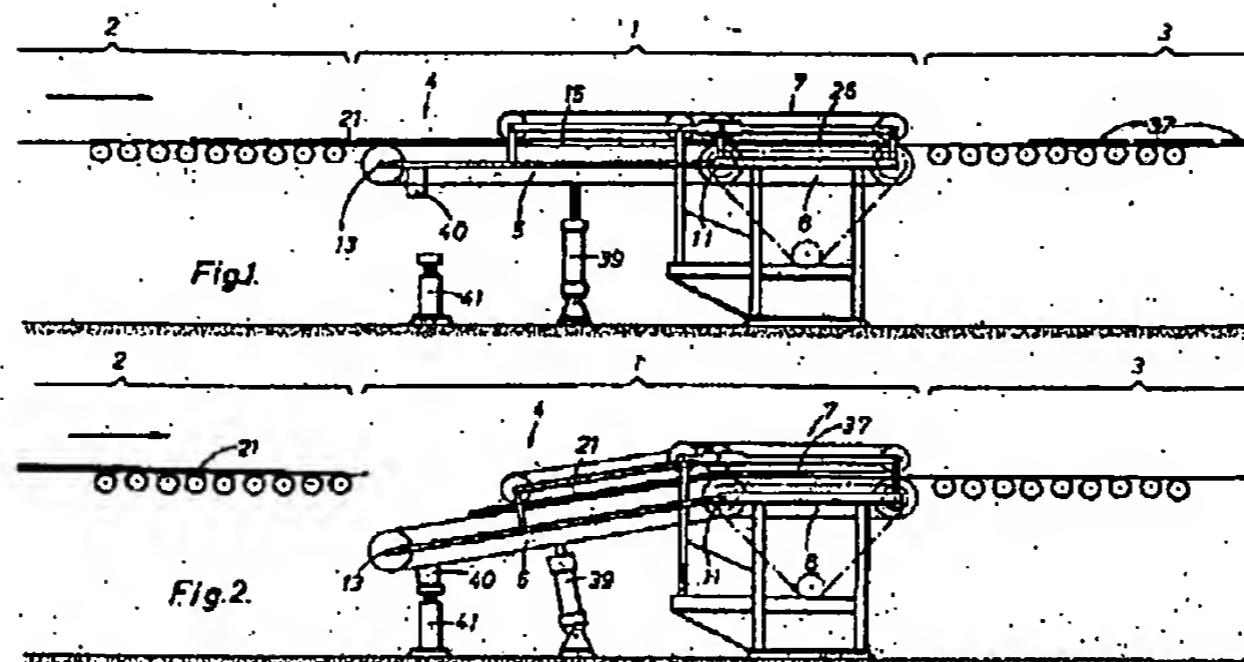
- (1) indicated that Claims 3 and 8 would be allowable if written in independent form, and
- (2) cited a new reference -- U.S. Patent No. 3,517,869 (Dryon) -- and rejected Claims 1, 2, 4-7, and 9 under 35 USC §102(b) as allegedly anticipated by this reference.

Applicant appreciates the indication of allowable subject matter for Claims 3 and 8. By the above amendment, Claim 8 has been written in independent form by incorporating therein all of the limitations of Claim 5 from which Claim 8 depended. Additional dependent claims, i.e., Claims 10-12, have also been added. These claims are identical to original dependent Claims 6, 7, and 9, but depend from Claim 8 instead of Claim 5.

As to Claim 5, that claim has been amended to further distinguish the claim from the newly-cited Dryon patent. In particular, rather than calling for separating a pane from a sheet of brittle material that moves continuously during steps (a), (b), and (c), and thus can be stationary at other times, the claim now calls for separating a pane from a "continually moving ribbon" of a brittle material. Support for this limitation can be found at, for example, page 11, line 5, of applicant's specification, as well as in Figures 1-12, where ribbon 13 is shown as continually moving.

Dryon plainly does not disclose or in any way suggest separating panes from a continually moving ribbon. Rather, it works exclusively with individual cut sheets (see Dryon's reference number 21), which are further sub-divided into what Dryon refers to as "cut-up masses" of glass (see Dryon's reference number 37). The following copies of Figures 1 and 2 illustrate the Dryon approach:

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In Dryon's own words, this equipment operates as follows:

For the operation of the arrangement described, reference will be made to FIGS. 1 and 2. FIG. 1 shows the mobile pair of conveyors 4 in the raised position so that the roller-train conveyor 2, the endless bands 15 of the lower mobile conveyor 5, the endless bands 26 of the lower fixed conveyor 8 and the roller-train conveyor 3 are in the same plane. In this position, the sheets of glass 21, the length of which can correspond substantially to that of the endless bands 15, are passed successively from the scoring station on these bands 15 by the roller-train conveyor 2. When a sheet is placed on the lower conveyor 5, the latter is lowered from the side of the spindle 13 to cause its block 40 to rest on the stop 41 and it remains in this position until the whole sheet has crossed the inclined passage formed at the place of the common spindle 11, by the two successive pairs of upper and lower conveyors. The jack 39 then immediately raises the pair of conveyors 4 to allow the conveyor 5 to be loaded with a new sheet of glass, while the roller-train conveyor 3 removes the cut up masses of glass 37 towards the next work-station or towards storage. (Dryon at column 4, lines 23-43; emphasis added.)

This is clearly a batch process, not a continuous process as called for by amended Claim 5. As such, it does not disclose or suggest the subject matter of Claim 5.

The above amendments to Claim 5 were not made earlier in the prosecution of this application because Dryon was not cited earlier. In the November 16th Office Action the Examiner stated that the rejections were being made final because the

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"[a]pplicant's amendment necessitated the new ground(s) of rejection presented...."

Section 706.07(a) of the MPEP states:

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element. (emphasis added)

Applicant respectfully submits that the changes made to the claims of this application by the amendment filed on August 22, 2005 were changes which "should reasonably" have been expected to be made. Thus, the following wherein clause was added to independent Claims 1 and 5: "wherein the sheet moves continuously during (a), (b), and (c)." As discussed in the paragraph bridging pages 5-6 of applicant's August 22nd Amendment, this "wherein" clause was added in response to the following statement in the May 18, 2005 Office Action:

It should be noted that the claims do not positive[ly] set forth that the sheet is continuously moving throughout the method steps. (5/18/05 Office Action at ¶5 and ¶6.)

Plainly, the added wherein clause is one which the Examiner should reasonably have expected would have been made in response to this comment in the May 18th Office Action. Likewise, the other change made to Claims 1 and 5 in the August 22nd Amendment was one which the Examiner should have reasonably expected would be made. In this case, in paragraphs 5 and 6 of the May 18th Office Action, the Examiner wrote:

[I]t is not clear from the phrase "within an area defined by the length and width of the to-be-separated pane" if the releasably engaging step includes engaging the to-be-separated pane portion or any portion of the moving sheet.

In response, applicant added the following language to subparagraph (a) of Claims 1 and 5: "said area becoming the pane when separated from the sheet." Again, this added

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language is language the Examiner should reasonably have expected would have been added to applicant's claims.

Moreover, as explained in applicant's August 22nd Amendment, these amendments to Claims 1 and 5 were made solely for the purpose of expediting the prosecution of this application and not because they were needed to understand the original claims. Specifically, applicant believes that a person skilled in the art would interpret his claims in the same manner with and without the added language. See Phillips v. AWH Corp., 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005).

For all these reasons, applicant respectfully submits that the rejections based on the newly-cited Dryon patent should not have been final rejections. Alternatively, applicant submits that the amendments to Claim 5 satisfy the requirements of 37 CFR §1.116(b)(3) for a "showing of good and sufficient reasons why the amendment is necessary and was not earlier presented." Accordingly, in either case, entry of the amendment is respectfully requested.

Finally, as to independent Claim 1, applicant respectfully disagrees with the Examiner's assertion that Dryon anticipates this claim. Subparagraph (c) of this claim calls for:

passively moving the separated pane relative to the moving sheet using gravity as the motive force so that the pane and the sheet do not contact each other once separation occurs.

Put simply, Dryon is anything but passive. As interpreted by the Examiner in the November 16th Office Action, in Dryon, the separated pane is moved relative to the moving sheet by "spring 32 pull[ing] the pane 37 down from an inclined surface to a horizontal surface" (11/16/05 Office Action at page 3, lines 7-8). Moreover, to achieve separation of his "cut-up masses" of glass from his glass sheets, Dryon actively drives the sheets from inclined conveyors 4 to horizontal conveyors 7. The active driving is accomplished through the use of "toothed pinions 33 and 34 driven by a chain 35 passing over a pinion 36 mounted on the outer end of the shaft of a motor with speed-reducing gear. (Dryon at column 3, lines 61-63.) Plainly, this is not a passive system

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using gravity as the motive force as called for by Claim 1. Rather, it is unquestionably an active system using a motor as the motive force.

In addition to the differences between Dryon and applicant's independent claims discussed above, applicant's dependent claims further distinguish this reference. In particular, dependent Claims 2, 7, and 11 call for movement of a sheet (Claims 2 and 11) or ribbon (Claim 7) in a "substantially vertical" direction. In the November 16th Office Action, the Examiner states that the movement of Dryon's sheet has a "vertical vector component." Having a vertical component is clearly not the same as being "substantially vertical." As is evident from, for example, Dryon's Figures 1 and 2 reproduced above, Dryon's system is substantially horizontal, not substantially vertical. Accordingly, Dryon cannot fairly be said to anticipate dependent Claims 2, 7, or 11.

The above amendments to the claims are believed to put this application in condition for allowance. Alternatively, the amendments put the application in better condition for appeal, should such action be necessary. In either case, applicant respectfully requests entry of the amendment.

Respectfully submitted,

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Maurice M. Klee, Ph.D.
Reg. No. 30,399
Attorney for Applicant
1951 Burr Street
Fairfield, CT 06824
(203) 255-1400